

Client Matter No. 7288-102/10312532
Application No.: 10/725,857
Office Action Dated: January 7, 2011

PATENT

Amendments to the Drawings:

Applicant requests that Replacement Sheet 3/3 being submitted with this amendment and also as submitted in our previous reply filed July 29, 2010 be entered and replace the originally filed sheet 3/3.

REMARKS/ARGUMENTS

Drawing Objection

The Examiner has objected to the submitted replacement drawings which only added three reference numerals to originally filed Figure 6, on the grounds that “[the drawings] are not deemed commensurate with the original disclosure, which describes nothing of the relation of height between the inner and outer walls and gives them no particular mention at all.” The examiner concluded that “adding this emphasis now would be new matter.” The only authority cited for this objection was 37 CFR 1.83(a) which provides that “[t]he drawing ...must show every feature of the invention specified in the claims....”

Applicant respectfully points out that the Figure 6 in the replacement drawing is identical to Figure 6 as originally filed except for the addition of reference numbers 31, 32 and 35. These reference numbers point to features that existed in Figure 6 *at the time the application was originally filed*. Consequently, these changes to Figure 6 which add nothing substantive to Figure 6 cannot be new matter. Reference numerals by themselves convey nothing of substance and therefore are not “matter” in the application. Since reference numerals are not “matter” in the first instance, the addition of reference numerals to existing drawings cannot be “new” matter.

In making the objection to the drawings, the Examiner has cited only 37 CFR 1.83(a). However, the Examiner’s reliance on this authority to support the objection to the replacement drawings is misplaced. The reference numerals added to Figure 6 are *not* “features” of the invention and are *not* features “specified in the claims” as required by 37 CFR 1.83(a). Whatever might be the Examiner’s skepticism as to whether Figure 6 shows a relative height difference between the inner and outer walls of grooved ring, that skepticism is based on what Figure 6 as *originally filed* discloses. The addition of the reference numerals to point to those features in the originally filed drawings is not new matter. Accordingly, the Examiner’s objection to the Replacement Drawings is without any statutory, regulatory or case authority. Therefore, Applicant respectfully request that the objection to the Replacement Drawings be withdrawn.

Applicant also objects to the Examiner's position that revised substitute drawings previously submitted are not in compliance with 37 CFR 1.121(d) is without merit. 37 CFR 1.121(d) requires only that the drawings conform to the formal requirements of 37 CFR 1.84 and that all changes made to the drawings be explained. The Examiner has not recited any basis for the objection to the drawings based on the failure to comply with the formalities of 37 CFR 1.84 and consequently that cannot be the bases of the objection to the substitute drawings. Likewise, the Examiner has not objected to the drawings because the changes to the drawings were not explained. Indeed, the changes to the drawings were described both in the office action response to which the substitute drawings were first filed but also are fully describe in this office action above. Accordingly, the Examiner's position that the failure to file new substitute drawings or the application will be deemed abandoned is without any factual or legal basis and should therefore be withdrawn.

While Applicant disagrees with the Examiner's new matter rejection and position, it is noted that the objection to the drawings are procedural in nature and do not impact the Examiner's substantive new matter position. Applicant next addresses the substantive new matter rejection.

New Matter Rejection: Specification

"In establishing a disclosure, applicant may rely ... on the specification and drawing as filed ..." See MPEP § 608.01(I).

The Examiner apparently agrees that Figures 4, 5 and 6 each show a grooved ring [20] having an outer wall [28] and an inner wall [35]. The inner wall was not originally identified with a reference numeral with reference numeral [35] being added in the tendered replacement drawings.

The Examiner has objected to the language added in the specification and claims "the outer wall [28] being adjacent to the sidewall [10] of the receptacle [10] at a first distance above the closed bottom [6], the inner wall [35] being a second distance above the closed bottom [6], the second distance being less that the first distance." Applicant will address

each of the structure limitations recited in this added language to demonstrate that none of the recited structural limitation is new matter.

“The outer wall [28] being adjacent to the sidewall [10] of the receptacle”

The sidewall [10] and outer wall [28] are both recited in the specification and shown in the figures (e.g., Figures 1 and 5) as originally filed. Those structural elements cannot therefore be “new matter.” Likewise, Figure 4 unambiguously shows the outer wall [28] being “adjacent to the sidewall (shown as [10] in Figure 1) of the receptacle [22]. This relationship must necessarily be the case in view of the teaching in paragraph [0024] that the ring is “press-fit into the receptacle...” Since the outer wall being adjacent to the wall of the receptacle is unambiguously shown in Figure 4 and is disclosed in the specification, the “outer wall *being adjacent to the sidewall*” is not new matter.

“The outer wall [28] ... at a first distance above the closed bottom [6]”

The spatial relationship between the top edge of the outer wall [28] and the closed bottom [6] is unambiguously shown in Figure 5 and is explicitly recited in paragraph [0021] of the specification. The “top edge” [31] of the outer wall [28] was not explicitly identified in the original specification. However, the existence of a top edge [31] is inherent in the specification because the outer wall must terminate at some point since it is not infinite and therefore the outer wall must have a top edge. Furthermore, the top edge is unambiguously shown in original Figure 6. Accordingly, that the outer wall [28] has a top edge [31] a first distance from the bottom [6] cannot be new matter as it is fully disclosed at least in the Figures as originally filed. The amendment to the specification to explicitly recite what the drawings show and what is inherent in the specification cannot be new matter.

“The inner wall [35] being a second distance above the closed bottom [6]”

As with the outer wall, the inner wall, while not originally identified with a reference numeral, is nevertheless shown in Figures 4, 5 and 6. Furthermore, a grooved ring will inherently and necessarily have an inner wall on one side of the groove and an outer wall on the opposite side of the groove. Indeed, without those walls, there would be no groove. Like the outer wall, the inner wall must also necessarily have a top edge since it obviously cannot be a wall of infinite height. This is also shown in Figures 4, 5, and 6. Reciting the inner wall structure [35] and its top edge [32] with new reference numerals is not new matter since those

structural features were shown in the original drawings as filed. Amending the specification to explicitly recite what the drawings clearly showed in the application as filed is not new matter. Likewise inherent is that the top edge of the inner wall is a second distance above the bottom [6]. Since there is no basis in the specification or drawings that would support a characterization that the first and second distances are the same, they must be referred to as distinct "first" and "second" distances. Again, this cannot be new matter because it merely describes the structure as it was shown and described in the original application.

"The second distance being less than the first distance"

The Examiner seems to have focused on this structural feature as the primary reason for the new matter rejection. Applicant submits that this structural feature is not new matter but is clearly and unambiguously shown in Figure 6 and is inherent in the specification as originally filed. More specifically, the Examiner states that this feature has "never been defined in the specification to any significant detail, nor is such a relationship ever clearly demonstrated in the drawing." The Examiner also states that "while it may be considered the inner wall may appear lower in Figure 6, it is not definite from the original disclosure as such was never clearly defined, and its reliance as the crux of the applicant's invention at the time of the invention was submitted is in doubt."

Applicant first notes that, the Examiner has cited no authority to support a rejection that an applicant must identify the "crux of the invention" at the time of filing. Indeed, claims are often amended to claim one or more disclosed features that, while disclosed, were not originally recognized as being novel and unobvious over the prior art. Amending claims to refocus the invention as claimed is quite common. Applicant submits that the "crux of the invention" rejection is not supported by any authority and must be withdrawn.

The Examiner's statement that the recitation of the second distance being less than the first distance is "not definite" is also without merit. Consider what Figure 6 definitely does not show: Figure 6 definitely does not show that the inner wall is higher than the outer wall. If Applicant had included such a structural feature in the claim, the Examiner would have been correct in a new matter rejection. Figure 6 likewise does not disclose that the inner and outer walls are the same height. Again, based on Figure 6 alone, there would be no basis for a claim that included a limitation stating the inner and outer walls were the same height.

Again, a new matter rejection would have been justified had this been the limitation claimed. An interpretation that the inner and outer walls were the same height would contradict paragraph [0024] which recites that the outer wall includes a lip [30] while the inner wall does not. Consequently, the only possible disclosure of Figure 6 is that the outer wall is higher than the inner wall. Furthermore, paragraph [0021] recites that one function of the ring is to prevent liquid in the groove from splashing *out* which would suggest to any person skilled in the art that the inner wall must be such as to direct liquid toward the inner part of the receptacle and that can only occur when the inner wall is lower than the outer wall.

Finally, Applicant notes that conforming the specification to the drawings by describing in the specification what is shown in the drawing is not new matter.

For each of the above reasons, Applicant respectfully requests reconsideration and withdrawal of the objection to the replacement drawings and reconsideration and withdrawal of the new matter rejection of the amended specification and claims.

With respect to the remaining rejections under 35 U.S.C. 103, Applicant hereby incorporates by reference its arguments and authorities submitted 29 July 2010.

CONCLUSION

No fees are believed due with this submission. However, if the Commissioner determines that additional fees or credits are due, the Commissioner is authorized to charge fees due or issue credits to Deposit Account 503632. Please ensure that Attorney Docket No. 7288-102/10312532 is referred to for this case.

Respectfully submitted,

Date: March 4, 2011

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